REMARKS

The present communication is made in response to the Official Action mailed March 14, 2006. A petition for a three-extension of the term for response to said Official Action, to and including September 14, 2006, is transmitted herewith.

Applicant hereby acknowledges and affirms the provisional election made during a telephone interview with the Examiner by Matthey Hanley on March 2, 2006, in which claims 1-19 were provisionally elected, without traverse. Accordingly claims 1-19 are pending in the current application, claims 20-29 being withdrawn from consideration. Claims 1 and 13 are currently amended.

Claims 1, 13 and 18-19 of the present application stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 6,159,216 to *Burkinshaw et al.* ("*Burkinshaw*"). In forming the rejection of claims 1, 13 and 18-19, the examiner asserts that *Burkinshaw* discloses a device having a punch or keel punch having a proximal end and a distal end, and a pivot between the proximal and distal ends of the punch system. Applicant respectfully traverses this assertion as erroneous.

Specifically, applicant asserts that sleeve 52, as disclosed in *Burkinshaw*, should not be considered "a pivot as the point of rotation between the upper, proximal portion and the lower distal portion." As shown in FIG. 1 of the current application, pivot 22 is shown as including the point about which proximal portion rotates with respect to distal portion (certain preferred embodiments of the pivot discussed in the present application further include pin 40 and slot 38). The specification and figures of the present application consistently reflect the position of the pivot as being located between the proximal and distal portions of the punch and having a longitudinal axis that extends transversely between proximal and distal portions. Sleeve 52, as shown and discussed in *Burkinshaw*, is not located between the proximal and distal portions, but rather through the proximal and distal portions. Sleeve 52 has an axis that lies along the longitudinal axis of shaft portion 55 that clearly is through both the proximal and distal portions thereof, and not between them. This allows for the rotation of shaft portion 55 by turning grip member 58 to disengage threaded portion 56 from receiver 44. (*Burkinshaw* col.4, ll.8-10.) It is also noted that the proximal portion of the shaft member disclosed in *Burkinshaw* does not rotate with respect to the distal portion, as asserted by the examiner. Rather, the entire shaft portion rotates as a single unit.

The examiner asserts that *Burkinshaw* also discloses that the keel punch is capable of being extracted by a prying force and guide for guiding the punch into a bone during advancement of the punch, and a lever portion capable of aiding in the extraction of the punch from the bone. The examiner points to column 4, lines 3-40 of *Burkinshaw* as disclosing the use of a prying force. Although this section discusses various methods for removal of keel broach trial member 16 from the tibia, nothing within the cited section either teaches or suggests the use of prying. The examiner asserts that handle 18 as shown and discussed in *Burkinshaw* is a lever, presumably as recited in claim 13 of the present application. However, at column 4, lines 22-27, *Burkinshaw* teaches that handle 18 accepts an alignment rod to aid in axial alignment of the baseplate trial. Nothing within *Burkinshaw* teaches that handle 18 is a lever, let alone a lever used in the extraction of a punch from a bone. Accordingly, applicant respectfully requests that the § 102 rejections made against claims 1, 13 and 18-19 be withdrawn.

Claims 1-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,690,636 to *Wildgoose, et al.* ("*Wildgoose*") in view of U.S. Patent No. 4,416,278 to *Miller* ("*Miller*"). Applicant respectfully traverses this rejection as it may apply to the newly-amended claims. In making this rejection, the examiner asserts that *Wildgoose* discloses a device having a punch and a pivot between the proximal and distal portions. Applicant respectfully asserts that *Wildgoose* does not teach a pivot. The examiner contends that a pivot portion is shown in *Wildgoose* as hole 13, "the point at which the two portions may move in relation to one another." However nothing in *Wildgoose* teaches or suggests that stem 14 of the slap hammer taught in *Wildgoose* rotates within hole 13, or that the two portions of shaft 14 rotate with respect to one another.

Further, the examiner asserts that *Wildgoose* discloses "a fulcrum (81) capable of contacting a portion of the proximal end in use wherein the raised surface (also 81) may be adjacent to the guide." Applicant respectfully asserts that this contention is also erroneous. As disclosed in *Wildgoose*, element 81 is not a fulcrum, but rather a button which is used to control attachment of the punch guide to the tray trial. (Col.3, ll.12-14.) Further, nothing within *Wildgoose* either teaches or suggests that button 81 contacts proximal portion (which the examiner has previously pointed to as part of shaft 14).

The examiner also states that element 31 in *Wildgoose* is a locking member. Applicant respectfully asserts that element 31 in *Wildgoose* is not a locking member but rather is a "standard cement punch." (Col.3, l.39.) Also, the examiner asserts that element 76 in *Wildgoose* is a "lever that is capable of aiding in the extraction of the punch from the bone." Applicant respectfully points out to the examiner that element 76 in *Wildgoose* is "a modular non-cemented punch guide." (Col.4, ll.66-67.) The examiner has offered no explanation as to how the modular non-cemented punch guide 76 can be used as a lever that is capable of aiding in the extraction of the punch from the bone. Accordingly, applicant respectfully requests that the examiner reconsider his position with respect to the application of *Wildgoose* to all of the claim limitations discussed above.

Further, the examiner asserts that *Wildgoose* teaches the claimed invention except for "a pivot permitting the proximal portion to be rotated with respect to the longitudinal axis, a pivot area that includes an elongated slot configured for advancement and retraction and a pin," and that *Miller* teaches such limitations. Currently amended claims 1 and 13 include recitations to the effect that the proximal portion rotates about the pivot to allow for alignment of the proximal portion with the longitudinal axis. Applicant asserts that the combination of *Wildgoose* and *Miller* fails to teach or suggest that the proximal portion is rotatable about the pivot such that the proximal portion is aligned with the longitudinal axis and such that the proximal portion is angled with respect to the longitudinal axis.

As previously asserted, nothing in *Wildgoose* teaches or suggests a pivot between the proximal and distal portions; thus, any such suggestion would have to be found in *Miller*. *Miller* states that "[a] basic and *critical* feature of the invention is that it is constructed in the form of a class 2 lever." (Col.2, ll.31-32 (emphasis added).) *Miller* describes a class 2 lever as one where the resisting force (applied at pin 4) "is located between the fulcrum [7] or hinge point of the device and the handle [6] or point of force application of the device." The handle 6 of the class 2 lever taught in *Miller* can not be aligned with the longitudinal axis of plunger 8.

Accordingly, *Miller* does not teach or suggest such a limitation, nor would such a limitation be obvious to one of reasonable skill in the art in light of *Miller*, and applicant respectfully asserts that that claims 1 and 13 are, therefore, patentable.

Applicant further requests that the § 103 rejections of claims 3-12 and 14-17 be withdrawn. At the very least, such claims depend from an allowable base claim. In addition, such claim contain features not present in the references asserted under § 103, alone or as properly combined.

As it is believed that all of the rejections set forth in the Official Action have been fully met by the foregoing amendments and remarks, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: September 14, 2006

Respectfully submitted,

By
Michael T. Hages
Registration No.: 57,110
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant